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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,332	03/25/2004	Hidenori Kuwajima	0397-0477PUS1	5433
2292 7590 02/28/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER HUYNH, NAM TRUNG	
			ART UNIT	PAPER NUMBER
			2617	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	02/28/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

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<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/808,332		KUWAJIMA, HIDENORI	
	<b>Examiner</b>		<b>Art Unit</b>	
	Nam Huynh		2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 November 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 7-15, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-15, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/3/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

This office action is in response to amendment filed on 11/15/2006. Of the pending claims 1-18, claims 1, 4, 5, 7, 11, and 14 have been amended and claims 6 and 16 have been cancelled.

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-5 and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohinata (US 2003/0129964) in view of Powell (US 5,991,617).

A. Regarding claims 1, 5, and 11, Kohinata et al. discloses a cellular phone comprising the following:

- A bio data storage unit (personal authentication information storing section) (figure 1, item 21) that stores fingerprint data or personal authentication

information from at least one or more fingers of the owner of the cellular phone (page 3, paragraph 0044).

- Bio data obtaining units (identity information inputting section) (figure 1, item 19) that obtains fingerprint data or allows a user to input identity information.
- An authentication unit (personal authentication section) (figure 1, item 20) that compares fingerprint data obtained by the bio data obtaining units with the fingerprint data stored in the bio data storage unit and notifies the result of comparison such as in agreement or not in agreement to the authentication management unit.

Kohinata et al. further teaches as prior art that when a user is judged to be an unauthenticated user, a limitation is often imposed on the functions that can be used on the cellular phone (disabling communication functions) (page 1, paragraph 8).

However, Kohinata et al. does not explicitly disclose that an informing section transmits an authentication result to the communication base station if personal authentication is failed and disabling communication functions after the result is transmitted.

Powell discloses a method for preventing cellular telephone fraud (title). In the scope of the invention, a user is authenticated by a first challenge-response authentication operation that includes prompting the user to enter identification information (column 4, lines 1-29). When authentication of a user fails, a counter counts the number of authentication failures (column 5, lines 15-24). This aspect of the invention renders the claimed "informing section" because authentication failures must be reported in order to maintain a count. When the authentication failure count reaches

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a predetermined value, an authentication disable signal is sent that cuts off service to the cellular phone (column 5, lines 34-54). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the cellular phone of Kohinata et al. to be capable of reporting authentication failures and disabling communication functions by the network, as taught by Powell, in order to indicate to the network fraudulent use of the cellular telephone and provide added security on the network level against such fraudulent use.

B. Regarding claims 2, 3, 12, and 13, the bio data storage unit of Kohinata et al. stores fingerprint data or personal authentication information (page 3, paragraph 44). It is further obvious to one of ordinary skill in the art that a "facial image" may be considered as personal authentication information because it identifies a person.

C. Regarding claims 4, 14, and 15, the limitations are rejected as applied to claim 1. Powell further teaches that the authentication operation is performed when a user attempts to make a call (attempts to use the mobile terminal communication function) (column 2, lines 28-32).

4. Claims 7-10, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohinata (US 2003/0129964) and Powell (US 5,991,617), as applied to claim 14, and further in view of Daudelin (6,915,123).

A. Regarding claims 7, 8, 17, and 18, the limitations are rejected as applied to claim 1. However, The combination of Kohinata et al. and Powell does not explicitly disclose that the base station stores owner information. Daudelin et al. discloses a method and system for monitoring an operational area of a subscriber station in which the base

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station (figure 1A, item 10) is connected to a home location register (figure 1A, item 30). The home location register stores subscriber information of the subscriber stations (page 6, lines 58-63). Furthermore, an operational area monitor within the base station of the wireless communications system may report communications activity of particular subscriber stations in their restricted coverage areas as potentially fraudulent activity and the authentication center provides reports to the service provider (column 7, lines 2-10). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the base station characteristics of Daudelin et al., in the communication system of the combination of Kohinata et al. and Powell, in order to monitor the area and location of a subscriber system and prevent fraudulent use.

B. Regarding claims 9 and 10, Daudelin et al. discloses that the home location register also provides an indication of where the subscriber station is active or what base station the subscriber station most recently used (column 6, lines 58-63). The home location register is connected to the authentication center (figure 1A) that provides reports to the service provider or a predetermined organization. Although the home location register and authentication center are not explicitly part of the base station, one of ordinary skill in the art would recognize that these components of the communications system can be interfaced within the base station because they are connected to each other.

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-5, 7-15, 17, and 18 have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Laniepce et al. (US 2004/0059915) (paragraphs 45-50)


Meche et al. (US 5,600,708) (column 8, lines 26-37)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nam Huynh whose telephone number is 571-272-5970. The examiner can normally be reached on 8 a.m.-5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NTH

  
GEORGE ENG  
SUPERVISORY PATENT EXAMINER